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IN RE APPLICATION OF : APPEAL NO. 1999-1627
TAKANOBU KAMAKURA : GROUP UNIT: 2814
SERIAL NO.: 08/578,980 : EXAMINER: WILLE, D.
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REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.197(b)

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the decision dated February 19, 2002, please note the following remarks requesting modification of decision and requesting proper treatment of the new grounds of rejection therein under 37 CFR §1.196(b) under CFR §1.197(b).

The decision dated February 19, 2002, is first of all improper as it does not address the points raised in the argument on page 5 of the Appeal Brief filed January 25, 1999, as follows:

Claim 1 requires that there must be "a first dense defect layer provided between the first electrode and the layers of the hetero-configuration" (emphasis added) with the first dense defect layer being made of a material described in Claim 1 as at least preventing "some of the crystal defects generated remotely from the layers of the hetero-configuration from reaching the layers of the hetero-configuration (emphasis added)." Claim 1 defines the hetero-configuration to be one "having an active layer that emits light when charge carriers are injected, a first clad layer, and a second clad layer, the active layer being interposed between the clad layers, the first and second clad layers each having an approximately equal thickness acting to keep the injected charge carriers in the active layer."

The claim 1 requirement that the layers of the hetero-configuration MUST include two clad layers could not be clearer. Also, the improper attempt by the Board to ignore this CLAIM REQUIREMENT could not be clearer in light of the misinterpretation of Claim 1 limitations in the page 4 statement of the decision that "we note that the claims do not preclude reading layers 31, 29 and 25 [portion of 25 between 27 and 29] as the hetero-configuration light emitting device. What the Board ignores is that Scifres defines all of layer 25 to be a cladding layer and states that "[a] principle aspect of this second laser embodiment is the presence of a strain layer 27 in cladding layer 25." [Emphasis added]. The board further ignores the precedent of In re Cortright, 49 USPQ 2d 1464, 1467 (Fed. Cir. 1999) that stated that "[a]lthough the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one those skilled in the art would reach" and then indicated that:

Prior art references may be "indicative of what all those skilled in the art generally believe a certain term means . . . [and] can often help to demonstrate how a disputed term is used by those skilled in the art." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584, 39 USPQ2d 1573, 1578-79 (Fed. Cir. 1996). Accordingly, the PTO's interpretation of claim terms should not be so broad that it conflicts with the meaning given to identical terms in other patents from analogous art. [Emphasis added.]

The Boards reading of only the part of the layer 25 defined by Scifres, an analogous art patent, to be one of the clad layers of the hetero-configuration of Scifres defies logic and precedent.

Moreover, the Board ignores that col. 5, lines 18-20 of Scifres provide a distance of $0.05\mu\text{m}$ as to that part of 25 that is between 27 and 29. On the other hand, col. 3, lines 55-56 of Scifres indicate cladding layer thicknesses to be typically about $1\mu\text{m}$. As cladding layer 31 would be implemented as a cladding layer of typical thickness (about $1\mu\text{m}$), where does the Board explain how the artisan would interpret the layer 31 typical thickness (about $1\mu\text{m}$)

to be "an approximately equal thickness" relative to the col. 5, lines 18-20 thickness of $0.05\mu\text{m}$?

The PTO reviewing court has stated that Board decisions asserting anticipation must meet minimum standards as to avoiding unwarranted conclusory findings and treating all claim limitations in Gechter v. Davidson, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

In the present case, the Board's opinion ..., makes conclusory findings relating to anticipation, and omits any analysis on several limitations. For example, the Board opinion does not separately construe the term "agent status messages" before finding that Canale discloses just such "agent status messages."

Accordingly, modification of the decision with a reasonable interpretation of the above-noted claim language as to a "hetero-configuration" the requirements for a "first clad layer, and a second clad layer, the active layer being interposed between the clad layers, the first and second clad layers each having an approximately equal thickness acting to keep the injected charge carriers in the active layer" is respectfully requested.

Furthermore, while the decision apparently attempts to acknowledge the further Claim 1 limitation of a "a first dense defect layer provided between the first electrode and the layers of the hetero-configuration, the first dense defect layer being made of a material having a concentration of crystal defects, a value of a lattice constant, and a thickness which together prevent at least some of the crystal defects generated remotely from the layers of the hetero-configuration from reaching the layers of the hetero-configuration, (emphasis added) it misstates the limitation as if it only said that the dense defect layer "prevents the hetero-configuration from at least some of the crystal defects as claimed" at the top of page 5 of the decision. Modification of the decision to correctly state the limitation and explain the Board's reasoning is clearly in order.

Furthermore, the top of page 5 of the decision specifically ignores the thrust of the rejection presented at page 9 of the Examiner's Answer in formulating its new reliance upon the supposed teachings of Scifres with regard to its new rationale for rejecting Claims 1, 3, and 5. As explained by In re Kronig, 190 USPQ 425, 427 (CCPA 1976), the rationale of the rejection advanced by the examiner and the board must have the same basic thrust or there is a new ground of rejection even though the same evidence is relied upon. As the thrust of the examiner's rationale is abandoned in favor of the Board's own, the proper designation of a new ground of rejection of Claims 1, 3, and 5 pursuant to 37 CFR § 1.196(b) is believed to be in order. The added reliance on Figure 1 to buttress the rejection of Claim 5 at the bottom of page 5 of the decision is even more clearly an improper new ground of rejection as obviousness, not anticipation is called into question.

With respect to the Rejection of Claims 2 and 8 under 35 U.S.C. §103(a) over Scifres in view of Inoue, the decision changes the thrust of the rejection at the bottom of page 6 by suggesting that Inoue is merely cumulative and newly relying on teachings at col.5, lines 10-32 and 53-65 of Inoue. This too is clearly a new rationale for the rejection that differs from the one advanced by the examiner that should have been designated as a new ground of rejection of Claims 2 and 8 pursuant to 37 CFR § 1.196(b).

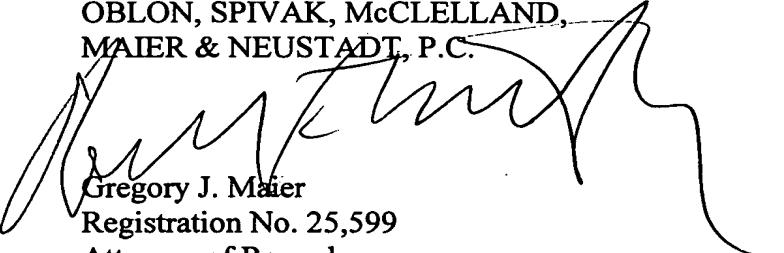
Similarly, the rationale offered in sustaining the rejection of Claims 4 and 6 under 35 U.S.C. §103(a) over Scifres in view of Sugawara includes reliance on Figure 1 of this application, evidence added by the board that was not relied upon by the examiner. This too is clearly a new rationale of the rejection that differs from the one advanced by the examiner that should have been designated as a new ground of rejection of Claims 4 and 6 pursuant to 37 CFR § 1.196(b).

Moreover, the decision makes no attempt to answer the specific arguments made as to Claim 8 at pages 14-15 of the Brief as to explaining how Scifres alone teaches the density specifically claimed or why the Inoue density disclosed only as to a cancellation layer would be used in a different type of layer. The Court requires more than mere conclusions from the Board, see In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) ("The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.").

Accordingly, reconsideration of the decision for the reasons set forth above is respectfully requested.

Respectfully submitted,

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